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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,796	01/10/2001	Atsushi Ishibashi	520.39445X00	6548

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EXAMINER

BUCKLEY, DENISE J

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,796

Applicant(s)

ISHIBASHI ET AL.

Examiner

Ms. Buckley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Election/Restrictions

1. Applicant's election without traverse of group I in Paper No. 6 is acknowledged.
2. Claims 6-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected claims, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Nuvomedia, Inc. (WO 99/49383). Nuvomedia Inc. discloses a contents display method of an electronic book system (30,31,32) with a portable reading terminal (30,figure 2) receiving digitized book contents (download book) and digitized related information proper to the book contents (and other types of contents, page 3,lines 25-33,page 6 last

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paragraph) via the internet (read the abstract), where the related information is displayed together with the book contents (see figure 10,150) by the operation of a button (34, or 148) of the portable reading terminal and operator guidance on the display screen(34). A suitable sentence or phrase is selected on the screen (highlight item figures 7-12, pages 6-8) on which the book contents are displayed. A retrieval list (goto bookmarks) which is a result of the retrieval of the books contents is displayed by selecting a retrieval (set bookmark here) on the operational menu display (book menu 85); and the corresponding page is displayed by selecting a suitable item in the retrieval list. (read table 1, of page 7, set bookmark here)

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Japan patent abstract (JP 07 129093). The abstract discloses a contents display method of an electronic book system (1, such as newspaper) with a portable reading terminal (2) receiving digitized book contents (external storage media) and digitized related information proper to the book contents (a piece of newspaper information is read out to a memory) via the internet (broadcasting wave, telephone line inherently used to access the internet), the Japan publication teaches advertisements by methods 1-5 listed in the abstract, where every time a page is turned advertising information is displayed on the screen.

4. Claims 1 and 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Motorola, Inc. (WO 97/22102). Motorola discloses a contents display method of an electronic book system (118) with a portable reading terminal (100) receiving digitized

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book contents (168) and digitized related information proper to the book contents (see figure 8, last paragraph) via the internet (page 17 lines 31-page 18 line 32), and already read pages and the residual pages of the corresponding book are acquired by selecting the display of the situation of reading on an operational menu display on the screen on which the book contents are displayed, and each number and each ratio of the already read pages and the residual pages are displayed. (see figure 10)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motorola, Inc. (WO 97 22102 A) in view of Japan patent abstract (JP 08 292957). Motorola, Inc. is discussed above. And further discloses data being overlapped on the portable terminal display. However, Motorola, Inc. does not disclose a terminal receiving a layout headline of a newspaper, character data consistent with a headline article is read by selecting the article of the layout headline, and the consistent with the headline data is overlapped on the layout headline toning down the layout headline. The Japan abstract teaches a terminal (50) receiving a layout headline of a newspaper (60-110), character data (62) consistent with a headline article is read by selecting the article of the layout headline (see abstract), and is capable of toning down the layout headline, by

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the coloring of the page section the headline originally came from (see abstract), and overlapping or superimposing the article over the screen the headline is on. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the headline displaying and headline article selection of the Japan abstract with the portable terminal electronic book system of Motorola, Inc in order to provide an article diverse type display method for electronic newspaper (see Japan abstract).

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Ohsuga, Sachs et al. ('034,'734), Mortimer et al., Mortimer et al., Richard et al., Hendricks, Iggulden et al., Sach et al., Huffman et al., Munyan, and Shwartz et. al. are cited to show electronic book systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Buckley whose telephone number is 703-305-0041. The examiner can normally be reached on Tues-Thurs 10-3 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 703-306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4180.

December 3, 2003



Ms. Buckley
Examiner
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